

REMARKS

Claims 37-50 are pending in the present application. Claim 45 has been amended. No new matter has been added.

Claims 37-50 are rejected under 35 U.S.C. § 103(a). Claims 37-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems et al. (U.S. Patent No. 6,434,403) (“Ausems”) in view of Dethloff (U.S. Patent No. 6,047,888) (“Dethloff”) and further in view of Pitroda (U.S. Patent No. 7,308,426) (“Pitroda ‘426”). Claim 44 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view of Dethloff in view of Pitroda ‘426 and further in view of Natsuno (U.S. Patent No. 6,910,624) (“Natsuno”). Claims 45, 47 and 49 stand as rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view of Pitroda (U.S. Patent No. 5,590,038) (“Pitroda ‘038”). Claim 46 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view of Pitroda ‘038 and further in view of Pitroda ‘426. Claim 48 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view Pitroda ‘038 and further in view of Natsuno. Claim 50 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view Pitroda ‘038 and further in view of Dethloff and Pitroda ‘426.

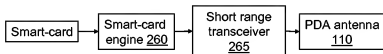
Rejection of Claims 37-43 under 35 U.S.C. § 103(a)

Claims 37-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view of Dethloff and further in view of Pitroda ‘426. This rejection is respectfully traversed.

Ausems, Dethloff, and Pitroda ‘426, alone or in combination, fail to teach or suggest each and every element of the pending claims. More specifically, Ausems, Dethloff, and Pitroda ‘426 fail to teach or suggest “wherein the second antenna communicates from the transaction card connected to the communication device to a merchant card reader to perform the transaction,” as recited in claim 37. On page 3 of the Office Action, the Examiner recognizes that Ausems does not disclose a second antenna embedded within a body of the transaction card for communication with a receiving terminal, wherein the second antenna communicates from the transaction card connected to the communication device to a merchant card reader to perform the transaction. In order to cure this deficiency, the Examiner asserts that Dethloff recites “a data medium or card 20 includes an antenna 46 for contactless communication with the vendor terminal,” citing Fig. 8 and col. 16, lines 5-50. Further, the Examiner asserts that Pitroda ‘426 recites “POS terminals include card readers; conducting transaction using electronic transaction device 12 at the POS

terminal 20,” citing col. 8, lines 5-35. On page 4 of the Office Action, the Examiner asserts that “it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Ausems’s to incorporate the feature taught by Dethloff’s and Pitroda’s above, for the purpose of providing a convenient way (contactless) for the transaction card to communicate with the receiving terminal.” However, this combination of references is improper.

Ausems is directed to a PDA that can interface with a smart-card engine. Col. 6, lines 13-15. “Smart-card engine 260 processes encoded information received from a smart-card and also provides the smart card writing capabilities. Short-range transceiver 265 is a low-power transceiver (e.g., a Bluetooth transceiver) coupled to smart-card engine 260 and antenna 110.” Col. 6, lines 19-23. As a result, Ausems communicates information from the smart-card as shown in the below schematic representation:



As a result, Ausems does not teach or suggest an antenna on a transaction card that communicates with a merchant card reader when the transaction card is connected to a communication device. Instead, Ausems uses the PDA to interface with a smart-card, then uses the antenna of the PDA to communicate any information. Indeed, Ausems is directed to the use of the PDA’s antenna for communicating all information. As a result, Ausems’s teaching conflicts with claim 37, which requires that the antenna on the transaction card communicate to the merchant card reader.

Dethloff fails to cure the deficiencies of Ausems and cannot be combined with Ausems. Dethloff recites a card 20 that has an antenna for contactless communication. Col. 16, lines 13-15. Dethloff recites that the card communicates directly with the vendor terminal without using a communication device. So whereas Dethloff requires communication from the card without a PDA, Ausems requires that any information from a smart-card is passed through the PDA for transmission. As a result, the combination of Dethloff and Ausems would render it useless for its purpose. Because Ausems funnels all transmissions through its PDA antenna, one of ordinary skill would not modify Ausems to communicate directly from the card without the use of the PDA antenna.

Pitroda '426 fails to cure the deficiencies of Ausems and Dethloff and cannot be combined with Ausems. The Examiner cites to Pitroda '426 merely for a teaching that a client can use an electronic transaction device to make a purchase from a vendor at a point of sale terminal using wireless data exchange. But Pitroda '426 does not teach or suggest communicating from the electronic transaction device while the electronic transaction device is connected to a communication device. Instead, like Dethloff, Pitroda '426 is directed to the use of only the electronic transaction device for performing a transaction.

Dethloff and Pitroda '426 do not provide any teaching, suggestion, or motivation to combine a card with an antenna (Dethloff) or an electronic transaction device (Pitroda '426) with a communication device. Further, there is no teaching, suggestion, or motivation in Ausems, Dethloff, or Pitroda '426 to combine a transaction card having an antenna with a communication device also having an antenna, but only using the transaction card's antenna to communicate with a merchant card reader. As a result, the combination of Ausems, Dethloff, and Pitroda '426 is improper.

Additionally, Ausems, Dethloff, and Pitroda '426 fail to teach or suggest "wherein the transaction card and the wireless communication device are provided together to a customer by a mobile telephone service provider during an application event," as recited in claim 37. On page 4 of the Office Action, the Examiner recognizes that "Ausems does not disclose wherein the transaction card and the wireless communication device are provided together to a customer by a mobile telephone service provider during an application event." Similarly, the Examiner does not even assert that Dethloff recites this feature. Instead, the Examiner asserts that Pitroda '426 recites "an electronic transaction device 12 and a Master card issued by Citibank are provided together to the client by the transaction service provider 10; the client can apply for a new credit card from a financial institution through the transaction service provider 10." The Examiner further asserts that it would have been obvious to modify Ausems to adopt the teachings of Pitroda '426 for providing to the customer various services associated with the wireless communication device in order to encourage the customer to purchase the wireless communication device. However, the Examiner's characterization of Pitroda '426 is improper and the combination of Pitroda '426 and Ausems is improper.

Pitroda '426a does not teach that a mobile telephone service provider provides a transaction card. Pitroda '426 recites that an exemplary service institution is Mastercard and a

partnering service institution may be an issuing bank, such as Citibank. Col. 11, lines 38-49. Thus, Pitroda '426's service institutions are financial institutions, *i.e.*, banks and credit card companies. Pitroda '426 further recites:

Issue account services include activating specific accounts, such as credit cards, on an electronic transaction device 12. The application for new cards from the issuing banks and service institutions may be provided *by the transaction service provider 10, or alternately by the issuing service institution.*

Col. 12, lines 6-11 (emphasis added). Neither the transaction service provider nor the issuing service institution is a mobile telephone service provider. Indeed, while it is known to one of ordinary skill in the art to obtain a credit card from a financial institution, it is patentably distinct to obtain a transaction card from a mobile telephone service provider. Because Pitroda '426 fails to teach this feature, the combination of Pitroda '426 and Ausems is improper.

Thus, Ausems, Dethloff and Pitroda '426, alone or in combination, fail to teach or suggest each and every limitation of independent claim 37. Therefore, the undersigned representative submits that dependent claims 38-43 are also allowable. Accordingly, it is respectfully requested that the rejection of claims 37-43 under 35 U.S.C. § 103 be withdrawn.

Rejection of Claim 44 under 35 U.S.C. § 103(a)

Claim 44 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view of Dethloff in view of Pitroda '426 and further in view of Natsuno. This rejection is respectfully traversed. As described above, Ausems, Dethloff, and Pitroda '426 fail to teach or suggest each and every limitation of independent claim 37. Natsuno fails to cure the deficiencies of Ausems, Dethloff, and Pitroda '426. Therefore, the undersigned representative submits that dependent claim 44 is also allowable. Accordingly, it is respectfully requested that the rejection of claim 44 under 35 U.S.C. § 103 be withdrawn.

Rejection of Claims 45, 47 and 49 under 35 U.S.C. § 103(a)

Claims 45, 47 and 49 stand as rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view of Pitroda '038. This rejection is respectfully traversed.

Ausems and Pitroda '038 fail to teach or suggest "wherein the smart card is provided by a mobile telephone service provider," as recited in amended claim 45. As discussed above with respect to claim 37, on page 4 of the Office Action, the Examiner recognizes that "Ausems does

not disclose wherein the transaction card and the wireless communication device are provided together to a customer by a mobile telephone service provider during an application event.” Accordingly, Ausems fails to teach or suggest this limitation. Pitroda ‘038 fails to cure the deficiencies of Ausems. Indeed, Pitroda ‘038 fails to even mention a mobile telephone service provider or how the mobile telephone service provider would provide the smart card.

Also, as discussed above with respect to claim 37, Pitroda ‘426 also fails to cure the deficiencies of Ausems and Pitroda ‘038. Pitroda ‘426 does not teach that a mobile telephone service provider provides a smart card. Pitroda ‘426 recites that an exemplary service institution is Mastercard and a partnering service institution may be an issuing bank, such as Citibank. Col. 11, lines 38-49. Thus, Pitroda ‘426’s service institutions are financial institutions, *i.e.*, banks and credit card companies. Pitroda ‘426 further recites:

Issue account services include activating specific accounts, such as credit cards, on an electronic transaction device 12. The application for new cards from the issuing banks and service institutions may be provided *by the transaction service provider 10, or alternately by the issuing service institution.*

Col. 12, lines 6-11 (emphasis added). Neither the transaction service provider nor the issuing service institution is a mobile telephone service provider. Indeed, while it is known to one of ordinary skill in the art to obtain a credit card from a financial institution, it is patentably distinct to obtain a smart card from a mobile telephone service provider.

Thus, Ausems and Pitroda ‘038 (as well as Pitroda ‘426) fail to teach or suggest each and every limitation of independent claim 45. Therefore, the undersigned representative submits that dependent claims 47 and 49 are also allowable. Accordingly, it is respectfully requested that the rejection of claims 45, 47 and 49 under 35 U.S.C. § 103 be withdrawn.

Rejection of Claim 46 under 35 U.S.C. § 103(a)

Claim 46 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view of Pitroda ‘038 and further in view of Pitroda ‘426. This rejection is respectfully traversed. As described above, Ausems and Pitroda ‘038 fail to teach or suggest each and every limitation of independent claim 45. Pitroda ‘426 fails to cure the deficiencies of Ausems and Pitroda ‘038. Therefore, the undersigned representative submits that dependent claim 46 is also allowable. Accordingly, it is respectfully requested that the rejection of claim 46 under 35 U.S.C. § 103 be withdrawn.

Rejection of Claim 48 under 35 U.S.C. § 103(a)

Claim 48 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view Pitroda '038 and further in view of Natsuno. This rejection is respectfully traversed. As described above, Ausems and Pitroda '038 fail to teach or suggest each and every limitation of independent claim 45. Natsuno fails to cure the deficiencies of Ausems and Pitroda '038. Therefore, the undersigned representative submits that dependent claim 48 is also allowable. Accordingly, it is respectfully requested that the rejection of claim 48 under 35 U.S.C. § 103 be withdrawn.

Rejection of Claim 50 under 35 U.S.C. § 103(a)

Claim 50 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ausems in view Pitroda '038 and further in view of Dethloff and Pitroda '426. This rejection is respectfully traversed. As described above, Ausems and Pitroda '038 fail to teach or suggest each and every limitation of independent claim 45. Dethloff and Pitroda '426 fail to cure the deficiencies of Ausems and Pitroda '038. Therefore, the undersigned representative submits that dependent claim 50 is also allowable. Accordingly, it is respectfully requested that the rejection of claim 50 under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 50-4402.

Respectfully submitted,

Date: February 20, 2009

KING & SPALDING LLP
1700 Pennsylvania Avenue, N.W.
Washington, D.C. 20006-4706
(202) 626-8980

By: /Eric Sophir Reg. No. 48,499/

Eric L. Sophir
Registration No. 48,499